

REMARKS

Applicants respectfully request entry of the amendments and remarks submitted herein. Independent claim 14 has been amended herein to incorporate the language from dependent claims 15 and 19. Accordingly, claims 15 and 19 have been canceled without prejudice to continued prosecution.

Claims 14, 16-18 and 20-37 are currently pending. Reconsideration of the pending application is respectfully requested.

The 35 U.S.C. §102 Rejections

Claims 14-23, 33-35 and 37 stand rejected under 35 U.S.C. §102(b) as being anticipated by Beauregard et al. (US Patent No. 6,458,401). According to the Examiner, Beauregard et al. discloses a process for preparing a powder containing crystalline particles of maltitol that includes the steps of continuously mixing, drying and grinding. The Examiner asserted that the disclosure in Beauregard et al. anticipates the process recited in independent claim 14. This rejection is respectfully traversed.

Beauregard et al. discloses a process for manufacturing a crystalline powder containing maltitol syrup and maltitol-containing seeds. On the other hand, the present claims are directed toward a process where maltitol syrup and maltitol powder are brought together to form a granulated product. In addition, Beauregard et al. discloses drying the maltitol powder on a fluid bed (see, for example, column 4, lines 65-57 and column 5, lines 3-4 (in Example 1)), however, independent claim 14 has been amended herein to require that the claimed process (i.e., not just the drying step) take place on a fluid bed.

Beauregard et al. does not anticipate pending independent claim 14 and claims depending therefrom. In view of the amendments and remarks herein, Applicants respectfully request that the rejection of the pending claims under 35 U.S.C. §102(b) be withdrawn.

The 35 U.S.C. §103 Rejections

Claims 27-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Beauregard et al. in view of Kawashima et al. (US Patent No. 5,583,215) and in further view of

Serpelloni (US Patent No. 4,831,129). According to the Examiner, although Beauregard et al. fails to disclose a maltitol product having a moisture content of less than 1%, Kawashima et al. discloses crystalline solid maltitol having 0.5% water content and Serpelloni discloses compressible powdered maltitol. Applicants respectfully traverse this rejection.

As discussed above, Beauregard et al. discloses a process for manufacturing a crystalline powder of maltitol. The process of Beauregard et al. includes continuously mixing maltitol syrup and maltitol-containing seeds by simultaneously dispersing the maltitol syrup and maltitol-containing seeds in a rotating open granulator (column 2, lines 35-45) and then crystallizing the maltitol. Example 1 in Beauregard et al. (column 4, line 36 to column 5, line 14) describes a process in which maltitol syrup and seed material are continuously introduced into a granulator spinning at 6.5 rpm (column 4, lines 47-61), and then matured by crystallizing (column 4, lines 62-64), rough grinding and drying in a fluidized bed (column 4, lines 65-67). Beauregard et al. requires using 4 parts maltitol-containing seeds and 1 part maltitol syrup (column 4, line 50) in their process, which, according to Beauregard et al., allows for efficient production of maltitol without requiring a high concentration of maltitol starting material. In addition, Kawashima describes crystalline maltitol and its process of preparation, which can include using an extruder (column 4, line 46), while Serpelloni describes a compressible powdered maltitol that can be extruded (column 1, line 62).

The present claims are directed toward methods of preparing solid maltitol. The claimed methods are self-feeding due to step d), which is directed toward recycling the product back into step a). In addition, step a) is directed toward making a granulated product by turbulating the maltitol powder and the maltitol-containing syrup on a fluidized bed at a temperature between about 20°C and a second temperature at which the maltitol powder is still solid. The turbulation ensures that the maltitol syrup contacts the entire surface of all the particles of maltitol powder and evaporates quickly to form the granulated product. As is apparent from Example 1, a granulated product produced by the claimed methods does not have to be matured.

Obviousness under 35 U.S.C. §103 requires consideration of the factors set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), including an analysis of the scope and content of the prior art and the differences between the claimed subject matter and the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). In addition, a "patent composed of

several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR*, 550 U.S. at 401. The Courts have clearly indicated that there must be some teaching, suggestion, or incentive to make the claimed invention beyond the mere disclosure of individual components of the claimed invention, either separately or in other combinations. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). Such a teaching, suggestion, or incentive to make the claimed combination must come from the prior art, and not the Applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicants submit that, for the reasons set forth herein, the cited references are insufficient to establish a *prima facie* case of obviousness.

Applicants note that, in the problem-solution approach adopted by some jurisdictions, if one assumes that Beauregard et al. is the closest prior art, the technical problems to be solved include how to modify the process of Beauregard et al. such that a granulated product may be obtained 1) rapidly; 2) without crystallization; 3) without a maturing step; and 4) without the use of very high seed-to-syrup ratios. Based on the combination of references cited by the Examiner, one of skill would not have arrived at the methods of claims 14 and 27, which provide a solution to each of the above-indicated problems. Although the cited references are linked by their disclosure of maltitol, the cited references describe very different grades of maltitol and, hence, very different methods of making the respective maltitol products. Therefore, Applicants submit that the cited references would not have been combined by a person skilled in the art.

In view of the amendments and remarks herein, Applicants respectfully request that the rejection of the pending claims under 35 U.S.C. §103(a) be withdrawn.

Claims 24-26 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Beauregard et al. in view of Serpelloni. According to the Examiner, Beauregard et al. does not disclose the maltitol content of powdered maltitol product, but Serpelloni discloses a process that produces maltitol powder at 95% by weight on a dry matter. The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to purify the powdered maltitol of Beauregard et al. using the methods of Serpelloni to achieve a maltitol richness of 95%. This rejection is respectfully traversed.

As indicated herein, the combination of Beauregard et al. and Serpelloni does not anticipate or make obvious pending independent claims 14 and 27. Therefore, dependent claims 24-26 and 36 also are not obvious. "Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious." *In re Fine*, 837 F.2d 1071 (C.A. Fed. 1988), citing *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); *In re Abele*, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); and *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, Applicants respectfully request that the rejection of claims 24-26 and 36 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

Applicants respectfully request allowance of claims 14, 16-18 and 20-37. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

/December 30, 2009/

/M. Angela Parsons/

Date: _____

M. Angela Parsons, Ph.D.
Reg. No. 44,282

Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (612) 335-5070
Facsimile: (877) 769-7945